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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,283	02/02/2004	Michael P. Maher	AUOBIO.026D2D1	9653

20995 7590 10/10/2007  
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EXAMINER
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FERNANDEZ, SUSAN EMILY

ART UNIT	PAPER NUMBER
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1651

NOTIFICATION DATE	DELIVERY MODE
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10/10/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/771,283

Applicant(s)

MAHER ET AL.

Examiner

Susan E. Fernandez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>20070920</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8-30-07</u> | 6) <input type="checkbox"/> Other: _____   |

### **DETAILED ACTION**

The amendment filed May 23, 2007, has been received and entered.

Claims 1-7 are pending and examined on the merits.

#### ***Claim Objections***

Claim 1 is objected to because of the following informalities: At line 10, the claim recites "a frequency" which should be replaced with "the frequency". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2, and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Catterall et al. (US 5,437,982) in view of Connolly et al. (Biosensors and Bioelectronics. 1990. 5: 223-234).

Catterall et al. discloses a method of identifying specific inactivation gate inhibitors of a sodium channel. Example 1 describes the steps involved in this method, wherein the host cells, Chinese hamster ovary cells, are first transfected with wild-type Type IIA sodium channels, the target ion channels (column 13, lines 10-13). Additionally, mutant (F1489Q) sodium channels are also expressed in other host cells (human kidney carcinoma cells), and these mutant channels are also target ion channels. The effects of a drug candidate, the KIFMK gate peptide, is observed on these target ion channels by introducing the KIFMK gate peptide into the cells (column 13, lines 18-27), and then applying a series of 10 Hz voltage pulses which were applied at different voltages (column 13, lines 27-29). These voltage pulses are depolarizing and activate (open) the Type IIA sodium channels (column 5, lines 42-44). Therefore, limitations in instant claims 5 and 6 are taught by the reference. It is noted that the ion channel is cycled between different voltage dependent states (closed state to an open state, or closed state to an inactivated state), as the cell membrane of the Chinese hamster ovary cells are repetitively depolarized (column 6, lines 1-7). With respect to the inhibitory effect of KIFMK on sodium channels, the experiments demonstrated that, "...there is no appreciable block when the channels are not repetitively cycling between the closed, activated and inactivated states" (column 13, lines 59-62). Clearly, limitations of instant claim 4 are taught by Catterall et al.

Catterall et al. differs from the claims under examination in that Catterall et al. does not expressly disclose that the repetitive application of electric fields taught in the reference is

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applied with extracellular electrodes. Instead, Catterall et al. discloses using filled electrodes which break through the cell membrane.

Connolly et al. teaches that when saline-filled glass microelectrodes for monitoring cell electrical activity which are positioned inside the cell membrane, are used "...there is always some risk of rupturing the cell membrane and destroying the cell," and that "it is difficult and very time consuming to work with several glass microelectrodes simultaneously *in vivo* or *in vitro*..." (page 223, last paragraph through page 224, first paragraph). As an alternative, Connolly et al. teaches extracellular electrodes (page 224, second paragraph). Though these extracellular electrodes are taught for monitoring cell electrical activity, it is noted that "it was found that extracellular stimulation of the cells was possible via the same electrodes used for recording" (page 223, abstract, last sentence).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have practiced the Catterall invention as discussed above with extracellular electrodes. One of ordinary skill in the art would have been motivated to do this since electrodes inserted into cells have the disadvantages of possibly destroying the cells, and may be difficult and time consuming to use. Moreover, as pointed out in Connolly et al., extracellular electrodes would have served as suitable substitutes of electrodes which are positioned inside cells.

Additionally, it would have been obvious to have performed various assays for identifying specific inactivation gate inhibitors of a sodium channel simultaneously by performing the method in various containers (wells) simultaneously.

Catterall et al. also differs from the claimed invention in that Catterall et al. does not expressly disclose that the frequency of the electric field pulses are within the range of  $\tau_M^{-1} \leq f$

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$\leq \tau_b^{-1}$  where  $\tau_M$  is a time constant for decay of transmembrane potential changes, and  $\tau_b$  is an average target ion channel open time. However, the selection of a specific suitable electric field pulse frequency range, including that claimed, clearly would have been an obvious matter of optimization on the part of the artisan of ordinary skill, particularly in view of the disclosure in Catterall et al. that the inhibitory effect of a drug candidate (KIFMK) on the sodium channel is frequency-dependent (column 13, lines 56-62).

Thus, a holding of obviousness is clearly required.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Catterall et al. and Connolly et al. as applied to claims 1, 2, and 4-6 above, and further in view of Tung et al. (Biophysical Journal, 1992, 63(2): 371-386).

As discussed above, Catterall et al. and Connolly et al. render claims 1, 2, and 4-6 obvious. However, these references do not expressly disclose repetitive application of biphasic electric fields.

Tung et al. discloses comparison of the effects of biphasic and monophasic electric fields on the electrical stimulation of cardiac cells (abstract). It was noted that "strength-duration curves derived from field stimulation show that over a wide range of pulse durations, biphasic waveforms can recruit and activate membrane patches about as effectively as can monophasic waveforms having the same total pulse duration" (abstract).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to practice the screening method with biphasic electric fields instead of monophasic electric fields.

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One of ordinary skill in the art would have been motivated to make this substitution in order to have stimulated the cells with a reasonable expectation of success.

Thus, a holding of obviousness is clearly required.

Claims 1, 2, and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Catterall et al. and Connolly et al. as applied to claims 1, 2, and 4-6 above, and further in view of Tsien et al. (WO 96/41166) or Denyer et al. (Drug Discovery Today, 1998, 3(7): 323-332).

As discussed above, Catterall et al. and Connolly et al. render claims 1, 2, and 4-6 obvious. However, Catterall et al. and Connolly et al. do not expressly disclose a method wherein the host cells comprise a voltage sensor.

Tsien et al. discloses a screening method for identifying drugs that affect ion channel activity corresponding to changes in membrane potentials in cells (pages 42 and 43). The invention comprises the steps of loading the cells with first and second reagents for measuring membrane potential (page 42, lines 31-33). The first reagent comprises a transmembrane potential redistribution dye, also described as a hydrophobic fluorescent ion capable of redistribution upon changes in membrane potential (page 3, lines 7-11). Furthermore, the transmembrane potential redistribution dye is considered an ion sensitive fluorescent molecule and an electrochromic transmembrane potential dye. The second reagent comprises a chromophore, preferably a fluorophore capable of FRET or electron transfer (page 3, lines 25-30). Thus the second reagent is considered a FRET based voltage sensor, an electrochromic transmembrane potential dye, or an ion sensitive fluorescent molecule.

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Denyer et al. reviews high throughput screening (HTS) methods for voltage-gated ion channel modulators. Radiotracers, including radioactive ions, are noted for their use in tracing ion flux through ion channels (page 328). Furthermore, high throughput methods have been established for enabling ion channel assays with radiotracers.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have injected the host cells of the Catterall invention with the voltage sensors disclosed in Tsien et al. or the radiotracers disclosed in Denyer et al.

One of ordinary skill in the art would have been motivated to do this since the use of voltage sensors disclosed in Tsien et al. and Denyer et al. would served equivalently to the current measurements taught in Catterall et al. in measuring the effect of the drug candidate on the target ion channels.

A holding of obviousness is clearly required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned



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with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 11/444214 in view of Catterall et al. (US 5,437,982). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application requires that extracellular electrodes are used and that a frequency of the electric field pulses are within a particular range. Nevertheless, the repetitive application of electric fields with extracellular electrodes as required by the instant application accomplishes the repetitive application of electric fields as required by 11/444214, and therefore renders obvious the invention of 11/444214. Moreover, the selection of a specific suitable electric field pulse frequency range, including that claimed, clearly would have been an obvious matter of optimization on the part of the artisan of ordinary skill, particularly in view of the disclosure in Catterall et al. that the inhibitory effect of a drug candidate on its target ion channel is frequency-dependent (column 13, lines 56-62), wherein Catterall et al. teaches a method of detecting the effect of a drug candidate on a target ion channel by repetitive application of electric field pulses after addition of the drug candidate to a population of host cells (column 13, lines 8-62).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Response to Arguments*

Applicant's arguments filed May 23, 2007, have been fully considered but they are not persuasive. Applicant argues that there is no indication in Connolly or Catterall that extracellular electrodes could be used to control transmembrane potential in a manner that allows drug candidate testing protocols to be effectively performed. However, as Connolly provides motivation for using extracellular electrodes, it would have been obvious to the person of ordinary skill in the art to have applied electrical pulses with extracellular electrodes when performing the Catterall invention. Moreover, there would have been a reasonable expectation of success in practicing the Catterall invention with extracellular electrodes since such electrodes can stimulate cells. Furthermore, as discussed above, the selection of a specific suitable electric field pulse frequency range, including that claimed, clearly would have been an obvious matter of optimization on the part of the artisan of ordinary skill, particularly in view of the disclosure in Catterall et al. that the inhibitory effect of a drug candidate (KIFMK) on the sodium channel is frequency-dependent. Thus, the limitations of claim 1 are rendered obvious by the prior art.

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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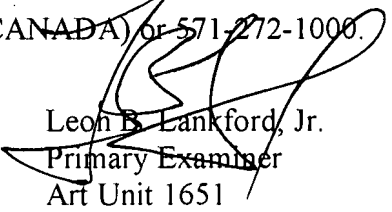
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan E. Fernandez whose telephone number is (571) 272-3444. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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